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Docket No. 2565-0136P PATENT

IN THE U.S. PATENT AND TRADEMARK OFFICE

APPLICANT: Shusou WADAKA et al.

APPL. NO.: 09/202,070 GROUP: 2834

FILED: December 8, 1998 EXAMINER: M. Budd

FOR: FILM ACOUSTIC WAVE DEVICE AND ITS MANUFACTURING METHOD AND CIRCUIT DEVICE

RESPONSE TO RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Date: February 25, 2000

Sir:

In response to the Office Action dated January 27, 2000, the following amendments and remarks are respectfully submitted in connection with the above-identified application.

REMARKS

The Examiner has initially required restriction between Group I, including claims 1-15, drawn to a film acoustic wave device, classified in Class 310, subclass 334; and Group II, including claims 16-23, drawn to a method of manufacturing a film acoustic wave device, classified in Class 29, subclass 25.35. Applicants respectfully elect **Group I**, including **claims 1-15**. However, Applicants respectfully traverse the Restriction Requirement for the following reasons.

Applicants respectfully submit that the Restriction Requirement is improper in that the governing standards for Unity of Invention have not been observed by the Examiner. Applicants respectfully submit that the present application has been filed under 35 U.S.C. § 371, and thus 35 U.S.C. §§ 121 and 372 require that PCT Unity of Invention Rule 13 be followed for national applications filed under 35 U.S.C. § 371. *See also* M.P.E.P. § 1893.03(d); 37 C.F.R. § 1.499.

Therefore, under PCT Rule 13, the appropriate standard for determining whether a group of inventions lack unity, and thus should be restricted into separate applications, is whether "there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features." *See* PCT Rule § 13.2. Moreover, "special technical features" means those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art. *Id.* Thus, Applicants respectfully submit that each of independent claims 1, 15 and 16 recite at least one similar "special technical feature". Accordingly, since under PCT Unity of Invention rules the groups of inventions indicated by the Examiner form a single general inventive concept and thus do not lack Unity of Invention, the Restriction Requirement is improper and therefore must be withdrawn for at least this reason alone.

Furthermore, 37 C.F.R. § 1.475 states that a national stage application will be considered to have Unity of Invention if the claims are drawn to a product and a process "specially adapted" for the manufacture of the product. *See* 37 C.F.R. § 1.475(b)(1). Moreover, M.P.E.P. §1893.03(d) states that a process is "specially adapted" for the manufacture of a product if the claimed process inherently produces the claimed product while having a technical relationship between the claimed process and the claimed product. *See* M.P.E.P. §1893.03(d).

However, M.P.E.P. §1893.03(d) also unequivocally states the expression "specially adapted" does not imply that the product could not also be manufactured by a different process. *Id.* Accordingly, Applicants respectfully submit that for this additional reason the Restriction Requirement must be withdrawn.

CONCLUSION

In the event that there are any outstanding matters remaining in the present application, the Examiner is invited to contact the undersigned at (703) 205-8000 in the Washington, D.C. area to discuss this application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. 1.16 or under 37 C.F.R. 1.17; particularly, extension of time fees.

Respectfully submitted,

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